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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,217	03/25/2005	Takao Aichi	00862.023326.	2027
5514 7590 05/09/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER WHIPKEY, JASON T				
ART UNIT 2622		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,217

Applicant(s)

AICHI ET AL.

Examiner

Jason T. Whipkey

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-43, 46-48 and 51-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-43, 46-48 and 51-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 15, 2008, has been entered.

Response to Arguments

2. Applicant's arguments filed February 15, 2008, have been fully considered but they are not persuasive.

Regarding the independent claims, on page 9-10 of the remarks, Applicant argues that neither Nishi nor Tanaka disclose storing a file describing a printing condition of the image data, as recited in the amended claims. The examiner disagrees.

On page 2, lines 16-18, of Applicant's specification, "print conditions" are defined to be "paper size, the number of copies, and the like." Similarly, Nishi discloses, "The automatic print file 60 ... contains the print type related with the product ID, the print number of sheets ..." (see paragraph 48 and Figure 7). Therefore, the Nishi reference does disclose storing a file describing printing conditions, as defined by the instant application, because the print file contains the number of sheets to be printed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 34-43, 46-48, and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (U.S. Patent Application Publication No. 2003/0081235) in view of Nishi (U.S. Patent Application Publication No. 2002/0097334).

Regarding **claims 34 and 39**, Tanaka discloses an image supply device (digital camera 3012; see Figure 10) comprising:

an interface (connector 3108) configured to connect with a storage medium (memory card 3109) that stores image data (see paragraph 65) and a file (operation is the same as creating a DPOF file; see paragraph 63) describing a

printing method of the image data (including paper size, color/monochrome, and framing; see *id.*) before starting communication with a printing apparatus (the user designates images to be printed and requests printing, at which point the process shown in Figure 11 is carried out; in step S12, the process in Figure 7 is executed [see paragraph 68], wherein the camera determines whether a printer is even connected [see paragraph 59]);

a confirmation unit (CPU 3100) configured to confirm whether it is possible or not to communicate with the printing apparatus using a predetermined protocol (a PD printer protocol, as shown in Figure 12; see paragraph 67) upon starting communication with the printing apparatus (at step S12 in Figure 11, the system determines whether the connected printer is a PD printer; see paragraphs 68-69); and

a transmission unit (I/F 3110) configured to transmit a print designation created based on the communication with the printing apparatus, after said confirmation unit confirms that it is possible to communicate with the printing apparatus using the predetermined protocol (a PrintRequest is sent if the printer is a PD printer [see step S14 in Figure 11]).

While Tanaka discloses “designation of a print image in the digital camera 3012 is basically the same as an operation of creating a DPOF file” (see paragraph 63) and that print instructions are transmitted to the printer (see paragraph 68), he is silent with regard to transmitting a file describing a printing condition.

Nishi discloses a digital camera that creates a DPOF file 60 and transmits it to a printer (see paragraph 48). The DPOF file includes printing condition data, such as the number of sheets to be printed (see Figure 7 and paragraph 48). As suggested in paragraph 3, an advantage of transmitting a DPOF file to a printer is that printing preferences (i.e., conditions) can be chosen in advance and executed without user intervention. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Tanaka's system send a printing condition file to the printer.

Regarding **claims 35 and 40**, Tanaka discloses:

the print designation describes information for specifying the file (the PrintRequest designates the file to be printed; see paragraph 65).

Regarding **claims 36 and 41**, Tanaka discloses:

a conversion unit (CPU 3100) configured to convert the contents of the file into a print designation set by the predetermined protocol, in a case that the printing apparatus cannot interpret the file (see paragraph 69).

Claim 37 can be treated like claim 34. However, Tanaka does not explicitly disclose using a DPOF file. Nishi discloses:

the file is recorded in the storage medium based on the standard of DPOF (see paragraph 48).

As stated in paragraph 3, an advantage of using the DPOF standard is that the standard makes it easier to output image data to paper. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Tanaka's system use the DPOF standard, as described by Nishi.

Regarding **claim 38**, Tanaka discloses:

an input unit configured to input print conditions (switches 3103; see paragraphs 63 and 65); and

a creation unit (CPU 3100) configured to create the file in the storage medium based on the input by said input unit before the start of the communication with the printing apparatus (see paragraph 63).

Claim 42 can be treated like claims 37 and 38.

Regarding **claims 43 and 48**, Tanaka discloses a printing apparatus (1000) for communication with an image supply device (digital camera 3012) having an interface (connector 3108) configured to connect with a storage medium (memory card 3109) that stores image data (see paragraph 65) and a file (operation is the same as creating a DPOF file; see paragraph 63) describing a printing method of the image data (including paper size, color/monochrome, and framing; see *id.*) before starting communication with said printing apparatus (the user designates images to be printed and requests printing, at which point the process shown in Figure 11 is carried out; in step S12, the process in Figure 7 is executed [see paragraph 68], wherein the camera determines whether a printer is even connected [see paragraph 59]), the apparatus comprising:

a confirmation unit (ASIC 3001) configured to confirm whether it is possible or not to communicate with the image supply device using a predetermined protocol (a PD printer protocol, as shown in Figure 12; see paragraph 67) upon starting the communication with the image supply device (at

step S12 in Figure 11, the system determines whether the connected printer is a PD printer; see paragraphs 68-69);

a reception unit (connector unit 3005) configured to receive a print designation that includes information for specifying the file, created based on the communication with the image supply device, after said confirmation unit confirms that it is possible to communicate with the image supply device using the predetermined protocol (a PrintRequest is sent if the printer is a PD printer [see step S14 in Figure 11]), from the image supply device; and

a transmission unit (connector unit 3005) configured to transmit a transfer request for the file to the image supply device (in step S15), based on the information for specifying the file in the print designation (see paragraph 68).

While Tanaka discloses “designation of a print image in the digital camera 3012 is basically the same as an operation of creating a DPOF file” (see paragraph 63) and that print instructions are transmitted to the printer (see paragraph 68), he is silent with regard to transmitting a file describing a printing condition.

Nishi discloses a digital camera that creates a DPOF file 60 and transmits it to a printer (see paragraph 48). The DPOF file includes printing condition data, such as the number of sheets to be printed (see Figure 7 and paragraph 48). As suggested in paragraph 3, an advantage of transmitting a DPOF file to a printer is that printing preferences (i.e., conditions) can be chosen in advance and executed without user intervention. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Tanaka’s system send a printing condition file to the printer.

Regarding **claims 46 and 51**, Tanaka discloses:

a request unit (ASIC 3001) configured to interpret the contents of the file and request image data for the image supply device using the predetermined protocol (see paragraphs 67-68).

Claims 47 and 52 can be treated like claim 34. However, Tanaka does not explicitly disclose using a DPOF file. Nishi discloses:

the file is recorded in the storage medium based on the standard of DPOF before start of the communication with the image supply device (see paragraph 48).

As stated in paragraph 3, an advantage of using the DPOF standard is that the standard makes it easier to output image data to paper. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Tanaka's system use the DPOF standard, as described by Nishi.

Regarding **claim 53**, Tanaka discloses a digital camera (3012 in Figure 10) comprising:

a photographing unit (CCD 3106) configured to acquire image data by photographing (see paragraph 65);

a setting unit (switches 3103) configured to set a printing method of image data stored in a storage medium (including paper size, color/monochrome, and framing; see paragraphs 63 and 65);

an interface (connector 3108) configured to connect with the storage medium (memory card 3109) that stores the image data acquired by said photographing unit (see paragraph 65) and a file (operation is the same as creating

a DPOF file; see paragraph 63) describing the printing method set by said setting unit before starting communication with a printer (the user designates images to be printed and requests printing, at which point the process shown in Figure 11 is carried out; in step S12, the process in Figure 7 is executed [see paragraph 68], wherein the camera determines whether a printer is even connected [see paragraph 59]);

a serial bus interface (USB interface 3110) configured to communicate with the printer (see paragraph 65) using a predetermined protocol (a PD printer protocol, as shown in Figure 12; see paragraph 67);

a confirmation unit (CPU 3100) configured to confirm whether it is possible or not to communicate with the printer using the predetermined protocol (a PD printer protocol, as shown in Figure 12; see paragraph 67) via said serial bus interface; and

a transmission unit (I/F 3110) configured to transmit a print designation created based on the communication with the printer via said serial bus interface, after said confirmation unit confirms that it is possible to communicate with the printer using the predetermined protocol (a PrintRequest is sent if the printer is a PD printer [see step S14 in Figure 11]), to the printer.

While Tanaka discloses “designation of a print image in the digital camera 3012 is basically the same as an operation of creating a DPOF file” (see paragraph 63) and that print instructions are transmitted to the printer (see paragraph 68), he is silent with regard to transmitting a file describing a printing condition.

Nishi discloses a digital camera that creates a DPOF file 60 and transmits it to a printer (see paragraph 48). The DPOF file includes printing condition data, such as the number of sheets to be printed (see Figure 7 and paragraph 48). As suggested in paragraph 3, an advantage of transmitting a DPOF file to a printer is that printing preferences (i.e., conditions) can be chosen in advance and executed without user intervention. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Tanaka's system send a printing condition file to the printer.

Regarding **claims 54**, Tanaka discloses:

the print designation describes information for specifying the file (the PrintRequest designates the file to be printed; see paragraph 65).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Whipkey, whose telephone number is (571) 272-7321. The examiner can normally be reached Monday through Friday from 9:30 A.M. to 6 P.M. eastern daylight time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye, can be reached at (571) 272-7372. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason T. Whipkey/
Examiner, Art Unit 2622